

REMARKS

Claims 1, 2, 4-8 and 10-22 are all the claims pending in the application.

The Examiner has withdrawn the pending rejection of the claims under section 102(b) based on Ullman and under section 103(a) based on Alfentino and Ichie. However, claims 1-2, 4-6 and 10-22 have been newly rejected under section 102(b) based on WO 98/51,283 (Mosaic). Further, claims 1-2, 4-8 and 10-22 have been rejected under section 103(a) based on Mosaic in view of Briggs (5,560,811).

The Applicant traverses the rejections and requests reconsideration.

I. Preliminary Matters

Applicant thanks the Examiner for initialing the references listed on form PTO-1449 submitted with the Information Disclosure Statement filed on January 8, 2004.

In the advisory action dated February 2, 2004, the Examiner contends that the newly added limitations were synonymous with existing limitations. The Applicants do not agree to this characterization.

II. Claim Rejections under 35 U.S.C. § 102

Claims 1-2, 4-6, and 10-22 are rejected under 35 U.S.C. § 102(b) as being anticipated by Mosaic Technologies ("Mosaic") (WO 98/51,823).

Claim 1 requires **fractionating** the captured target. The Examiner incorrectly contends that the electrophoresis in Mosaic fractionates the target. The Applicant respectfully submits that there is no disclosure (or suggestion) in Mosaic regarding fractionating the captured target. The

Examiner refers to passages on pp. 5, 29 and 30 of Mosaic. In these passages, Mosaic merely states that the target molecules **are immobilized within the electrophoresis medium and that the non-target molecules electrophorese out of the matrix**. In the last sentence on page 5, it is also stated that the captured probes are immobilized and that they do not migrate under the influence of the electric field. The Applicant respectfully submits that Mosaic does not suggest fractionating the captured target.

The plain meaning of the word “fractionate” involves breaking down or separating into some kinds of **fractions**. Mosaic, at best suggests separating target molecules from non-target molecules using electrophoresis. It does not suggest separating the target molecules themselves into fractions.

In a preferred non-limiting embodiment, **fractionating** involves distributing three-dimensionally in accordance with the molecular weights in the gel block (see Specification p. 22, ll. 7-11 & p. 42 ll. 1-3). Fractionating, as in the present invention requires distributing the capture target so that a fractionated target is obtained.

On the other hand, by electrophoresing, Mosaic merely captures and immobilizes the target molecules while removing the non-target molecules. Mosaic does not disclose (or suggest) fractionating the captured target to form fractionated target.

Clearly, in Mosaic the electrophoresis is utilized for performing hybridization. On the other hand, claim 1 requires performing electrophoresis for fractionating the target.

Claims 2, 4-6 and 10-22 depend on claim 1. Therefore, they are patentable at least for the same reasons.

III. Claim Rejections under 35 U.S.C. § 103

Claims 1-2, 4-8, and 10-22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Mosaic Technologies (“Mosaic”) (WO 98/51,823) and Briggs et al. (U.S. Patent No. 5,560,811).

Claims 1-2, 4-8 and 10-22 have also been rejected based on the combined teachings of Mosaic/Briggs.

As noted above, Mosaic is deficient at least to the extent that it does not teach fractionating the captured target to form fractionated target. The Applicants respectfully submit that Briggs does not overcome the deficiency noted above in the teachings of Mosaic.

A skilled artisan would not have been able to practice the present invention from the combined teachings of Mosaic and Briggs. Therefore, claims 1-2, 4-8 and 10-22 should be allowed.

IV. Conclusion

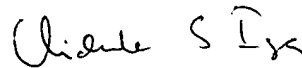
In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Request for Reconsideration under 37 C.F.R. § 1.111
U.S. Application No.: 09/644,175

Attorney Docket No.: Q65952

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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